

**REMARKS**

Entry of the foregoing, re-examination and reconsideration of the application identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.116 and in light of the remarks which follow are respectfully requested.

Respectfully, entry of the amendment will place the application in immediate condition for allowance for the reasons that follow. In addition, the features added into the independent Claim 1 have been previously considered at least in dependent Claims 8-9 and 12 and thus do not raise new issues. Accordingly, entry of the amendment is proper.

As correctly indicated in the Office Action summary, Claims 1 through 31 were pending, of which Claims 1-4, 6-13 and 15-31 were rejected and Claims 5 and 14 stood withdrawn from consideration.

Claims 1, 10-11 and 15-31 are currently pending in this application with the entry of this Amendment. By the present amendment, Claim 1 has been amended to recite the benzotriazole of formula (I') and at least the second sunscreen compound 2,4-bis {[4-(2-ethyl-hexyloxy)-2-hydroxy]phenyl}-6-(4-methoxyphenyl)-1,3,5-triazine formulated into a topically applicable, cosmetically acceptable vehicle, diluent or carrier therefor. Thus, support for these amendments can be found at least in the specification and original Claims 1-31 as filed. Respectfully, no new matter has been added by these amendments.

The above amendments have been presented solely for the purpose of expediting what appears to be allowable subject matter. Applicants reserve the right to file a continuation application directed to the originally presented claims.

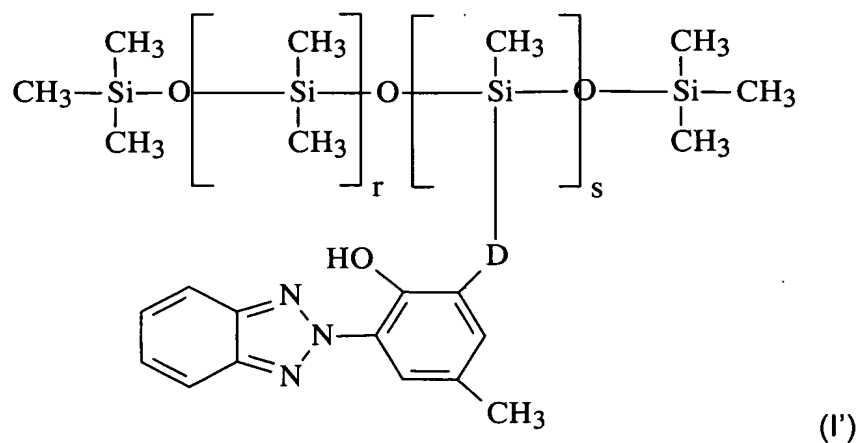
**I. THE REJECTION OF CLAIMS 1, 2, 6-11 and 15-31 UNDER 35 U.S.C. §102**

Claims 1, 2, 6-11 and 15-31 stand rejected under 35 U.S.C. §102(b) as being anticipated by Hüglin *et al.* (WO 99/08653) for the reasons of record. Respectfully, Applicants traverse this rejection.

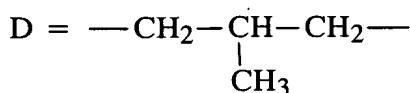
Based on a complete understanding of the present invention as claimed, it is respectfully submitted that the claims cannot properly be rejected based on the document as applied in the Official Action.

The invention relates to a topically applicable sunscreen/cosmetic composition suited for the photoprotection of human skin and/or hair, comprising an effective SPF-maintaining

and water remanence-enhancing amount of combinatory immixture of (a) at least one benzotriazole first sunscreen compound of formula (I'):



wherein  $r = 0$ ,  $s = 1$  and



(b) at least the second sunscreen compound 2,4-bis {[4-(2-ethyl-hexyloxy)-2-hydroxy]phenyl}-6-(4-methoxyphenyl)-1,3,5-triazine formulated into (c) a topically applicable, cosmetically acceptable vehicle, diluent or carrier therefor.

In contrast, the asserted document does not disclose each and every feature of the invention. According to the relevant standards, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

In this regard, *Hüglin et al.* does not teach or suggest the specific combination recited in the claims as amended.

For the above reasons, Applicants respectfully submit that withdrawal of the rejection under 35 U.S.C. §102 would be appropriate.

## **II. THE REJECTION OF CLAIMS 1-4, 6-13 AND 15-31 UNDER 35 U.S.C. §103**

Claims 1-4, 6-13 and 15-31 stand rejected under 35 U.S.C. §103(a) as being obvious over either *Hansenne* or *Allard et al.* in view of *Hüglin et al.* (EP 0 775 698 or US 5,955,060) for the reasons of record. Respectfully, Applicants traverse this rejection.

Based on a complete understanding of the present invention as claimed, it is respectfully submitted that the claims cannot properly be rejected based on the documents as applied in the Official Action, for the reasons previously discussed in detail in the Request for Reconsideration filed on November 7, 2003.

On page 5 of the Office Action dated January 28, 2004, the Examiner noted that the showing of unexpected results had been considered, but was not persuasive because the showing was allegedly not commensurate in scope with the claims. The Examiner notes that "if the instant claims are amended to be commensurate in scope with the showing of unexpected results, the claims will be allowed based on the demonstrated synergistic effect."

Consistent with the Examiner's suggestion, Applicants have amended the claims to recite the benzotriazole first sunscreen compound of formula (I') and the second sunscreen compound 2,4-bis {[4-(2-ethyl-hexyloxy)-2-hydroxy]phenyl}-6-(4-methoxyphenyl)-1,3,5-triazine.

It is respectfully requested that the claims as amended are in condition for allowance, and are commensurate in scope with the showing of unexpected results.

The above amendments have been presented solely for the purposes of expediting what appears to be allowable subject matter. For the record, Applicants continue to traverse the rejection under 35 U.S.C. §103 for the reasons previously presented in the Request for Reconsideration filed on November 7, 2003.

In summary, Applicant's invention exhibits an unexpected and superior combination of UV A absorption and SPF water resistance. Respectfully, the Office Action does not present a legally sufficient *prima facie* case of obviousness because the cited references do not fairly suggest that a topically applicable sunscreen/cosmetic composition suited for the photoprotection of human skin and/or hair, having effective SPF and enhanced water remanence could be obtained. However, should it be determined that such a case has been

made, Applicant submits that the unexpected and superior results overcome any showing of *prima facie* obviousness that may have been made out.

Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. §103.

### CONCLUSION

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited.

If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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Limited Recognition under 37 C.F.R. § 10.9(b)

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